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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/807,222  | 09/28/2001  | Toshiaki Nagai       | 109159              | 5955             |
| 7590  | 01/12/2006  |                      | EXAMINER            |                  |
| Oliff & Berridge<br>P O Box 19928<br>Alexandria, VA 22320 |             |                      | VIG, NARESH         |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3629                |                  |

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/807,222

Applicant(s)

NAGAI ET AL.

Examiner

Naresh Vig

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6-13 and 20-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-13 and 20-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>20010611</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of claims 6 – 13 and 20 – 23 in the reply filed on 28 October 2005 is acknowledged. This is not found persuasive because application has not provided reasoning on why examining of non-elected claims will not be a burden on the examiner. The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 6 – 13 and 20 – 23 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for network trading among members, does not reasonably provide enablement for determining predetermined members. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to determine who determines the predetermined members to enabling the network trading among the predetermined members.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6 – 13 and 20 – 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because it is not clear which member in the claim(s) performs which step of the method. Applicant recites both requester and provider as members in the claims.

Claim 7 recites the limitation “The network trading method according to claim 6, wherein the biometric information corresponds to handwritten signature data pertaining to the members”. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 6, 8, 9, 11, 12 and 20 – 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over EBay in view of an article Information Bid & Asked by Esther Dyson hereinafter known as Dyson.

Regarding claim 6, EBay teaches network trading among predetermined members (Registered users) through use of a management server (EBay system) having an electronic bulletin board function (EBay website). EBay teaches:

an invitation transmission step of sending to the management server by way of a network an tangible asset for which a member desires to invite applications (member posting tangible asset for other members to place a bid for). EBay does not explicitly teach an invitation transmission step of sending to the management server by way of a network an intangible asset for which a member desires to invite applications. However, Dyson teaches an invitation transmission step of sending to the management server by way of a network an intangible asset for which a member desires to invite applications (you may solicit advice about which brand of laser printers is best in your situation) [Dyson, lines 23 – 24].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify EBay as taught by Dyson to allows service providers offer their services to EBay members.

EBay in view of Dyson teaches:

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an invitation posting step of posting on an electronic bulletin board the invitation that has been transmitted (EBay posting gathered asset information from their member over EBay website) [EBay page 24];

an invitation browsing step in which other members browse the invitation of applications posted on the electronic bulletin board by means of accessing the management server by way of the network (EBay members accessing EBay to view assets posted by EBay members);

an application transmission step in which the members send information about their intangible or tangible assets to the management server by way of the network, in response to the invitation of applications posted on the electronic bulletin board (EBay members placing bid on an asset) [EBay page 38, member can call or email other member];

an application storage step in which the management server stores the applications that have been transmitted (EBay system storing asset information and member information on their system);

an application browsing step in which the member accesses the management server by way of the network, thereby browsing the stored applications (EBay page 24 – 25]; and

an application selection transmission step in which the member selects a desired application from the applications having been browsed and sends the result of selection to the management server by way of the network (EBay member placing a bid on an asset), wherein

the management server identifies the member who has invited applications and the members who have filed applications as authorized members (user authentication) when they access the management server and allows them to access the management server only when they are identified as authorized members [EBay page 46 – 47].

Regarding claim 8, EBay in view of Dyson teaches:

a public-order-and-standards-of-decency step of inspecting whether or not the intangible asset for which applications are invited violates public order and standards of decency (for example adult material, illegal items) [EBay, page 40 – 41] and

a first posting refusal step of refusing posting of the invitation on the electronic bulletin board when the intangible asset has been determined to violate public order and standards of decency in the public-order-and-standards-of-decency step [EBay, page 41].

Regarding claim 9, EBay in view of Dyson teaches a public-order-and-standards-of-decency step of inspecting whether or not an invitation of applications for an intangible asset analogous to an intangible asset for which invitation of applications is desired has already been posted on the electronic bulletin board; and

a second posting refusal step of refusing posting of the invitation on the electronic bulletin board when an invitation of applications for an analogous intangible asset is determined to have already been posted on the electronic bulletin board [EBay, page 38].

Regarding claim 11, EBay in view of Dyson teaches number of applications which have been filed thus far for the invitation is displayed for the other members (number of bids).

Regarding claim 12, EBay in view of Dyson teaches the member can select one application or two or more applications (selection of bids).

Regarding claim 13, EBay in view of Dyson teaches the member can invite an additional application for an intangible asset which represents an improvement over the intangible asset for which the selected application has been filed, in connection with a person who has filed the application selected by the member (private auction).

Regarding claims 20 – 23, EBay in view of Dyson capability to accommodate trading method wherein the intangible asset corresponds to knowledge, proposal or an idea, know-how, corresponds to intellectual property.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over EBay in view of an article Information Bid & Asked by Esther Dyson hereinafter known as Dyson and Houvener US Patent 5,657,389.



Regarding claim 7, EBay in view of Dyson does not teach biometric information corresponds to handwritten signature data pertaining to the members. However, Houvener teaches that biometric information like handwritten signature can be retrieved received from a user device and displayed on a computer system for verification.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify EBay in view of Axim as taught by Houvener to further ensure that the member is the legitimate member to use the system.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over EBay in view of an article Information Bid & Asked by Esther Dyson hereinafter known as Dyson and Anand Milk Union Ltd. hereinafter known as AMUL.

Regarding claim 10, EBay in view of Dyson does not teach the number of times other members have browsed details of the invitation of applications for the intangible or tangible asset is displayed for the other members (counter). However, Amul teaches counter for keeping track of number of times web page information is visited by a user.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify EBay as taught by Dyson to keep track on number of times a web page is accessed during the time webpage was available for access to members of system.

**Conclusion**

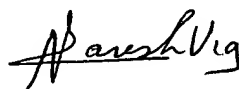
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action.

1. An article Join The Information Economy by Joel N. Orr.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is (571) 272-6810. The examiner can normally be reached on M-F 7:30 - 6:00 (Wednesday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Naresh Vig  
Examiner  
Art Unit 3629

January 9, 2006